



PATENT
Attorney Docket No. 23452-096

#17
1043

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Frank Alan PAVELSKI, *et al.* CONFIRMATION NO.: 9120
SERIAL NUMBER : 09/337,538 EXAMINER : MYLINH T. TRAN
FILING DATE : June 22, 1999 ART UNIT : 2174
FOR : SYSTEM AND METHOD FOR CUSTOMIZING WORKSPACE USING
PREDEFINED FRAMESETS

Appellants' Brief On Appeal Under 37 C.F.R. §1.192

ATTN: Board of Patent Appeals and Interferences
The Assistant Commissioner for Patents
Washington, D.C. 20231

RECEIVED

MAR 03 2003

Technology Center 2100

Sir:

Further to the Notice of Appeal filed on September 26, 2002, Appellants submit Appellants' Brief on Appeal in triplicate pursuant to 37 C.F.R. §1.192(a).

In accordance with §1.17(c), a check in the amount of \$1250.00 representing the fee for filing an Appeal Brief (\$320) as well as appropriate extension of time fees (\$930) is attached. It is believed that no other fees are due in connection with this submission, however, if it is determined otherwise, the Commissioner is authorized to credit any overpayment or charge any deficiencies to the undersigned's account, Deposit Account No. 50-0311

(1) REAL PARTY IN INTEREST

By virtue of the assignment recorded June 22, 1999 at reel 010063, frame 0519, the real party in interest is **International Business Machines Corporation**, a New York corporation having a place of business in Armonk, New York.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

(3) STATUS OF THE CLAIMS

Claims 1-28 are pending in this case. Claims 1-28 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,266,684 issued to Krause et al. ("Krause) in view of U.S. Patent No. 6,014,137 issued to Burns ("Burns").

Appellants' appeal the rejections of each of claims 1-28.

(4) STATUS OF AMENDMENTS

Appellants have not amended the claims subsequent to the Final Office Action dated April 19, 2002 ("Office Action").

(5) SUMMARY OF THE INVENTION

Appellants' invention is directed to a system for enabling a user to create a frameset arrangement for a view. The system includes a predefined frameset arrangement presentation object that presents a plurality of predefined frameset arrangements to a user through a graphical user interface, where the plurality of predefined frameset arrangements are displayed to a user. The system also includes a predefined frameset selection object that enables a user to select a predefined frameset arrangement through the graphical user interface and a view presentation object that presents a view to the user having the selected predefined frameset arrangement. Specification, page 5, lines 6-12, page 9, lines 8-26, and Figure 1 including elements 104a-d.

One feature of the present invention is that a plurality of predefined frameset arrangements are displayed to the user, so that the user may select one of the predefined frameset arrangements to generate a layout. This system allows a user to quickly select a frameset arrangement from a plurality of

predefined frameset arrangement and display the selected frameset arrangement. Specification, page 9, lines 18-26, and Figure 1 including elements 104a-d.

(6) ISSUES

Whether claims 1-28 are unpatentable, under 35 U.S.C. § 103(a), over Krause in view of Burns.

(7) GROUPING OF CLAIMS

Claims 1-28 are separately patentable. Appellants, however, grouped claims including similar features. In particular, Appellants request that claims 1, 8, 15, and 22 be considered to stand and fall together; that claims 2, 9, 16, and 23 be considered to stand and fall together; that claims 3, 10, 17, and 24 be considered to stand and fall together; that claims 4, 11, 18, and 25 be considered to stand and fall together; that claims 5, 12, 19, and 26 be considered to stand and fall together; that claims 6, 13, 20, and 27 be considered to stand and fall together; and that claims 7, 14, 21, and 28 be considered to stand and fall together.

(8) ARGUMENT

With respect to the issue presented above, the question to be resolved is whether the asserted rejection is a proper rejection under 35 U.S.C. § 103(a). Appellants respectfully submit that the asserted rejection is improper because the combination of the references cited by the Examiner fail to teach all the suggested claim limitations. In addition, Appellants respectfully submit that the asserted rejection is improper because the Examiner failed to provide proper motivation to combine the cited references. Appellants provide below a discussion of the requirements for a *prima facie* case of obviousness under 35 U.S.C. § 103(a) and an application of these requirements to each claim.

Requirements for prima facie case of obviousness

As stated in the MPEP § 2143, three requirements must be met to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). The requirements are: (1) the prior art must teach or suggest all the claim limitations, (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings, and (3) there must be a reasonable expectation of success.

Appellants respectfully submit that at least the first two requirements are not met by the asserted rejection. Therefore, Appellants examine those requirements in further detail.

All of the claim limitations must be taught or suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Suggestion or Motivation to modify the references

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Independent Claims 1, 8, 15, and 22

Appellants respectfully submit that the rejection of independent claims 1, 8, 15, and 22 as allegedly being unpatentable under 35 U.S.C. § 103(a) over Kraus in view of Burns is improper for failing to teach or suggest every claimed

feature and for failing to provide an adequate motivation to combine the references.

Claim 1 recites, *inter alia*, the features of “a predefined frameset arrangement presentation object that presents a plurality of predefined frameset arrangements to a user through a graphical user interface, wherein the plurality of predefined frameset arrangements are displayed as objects to a user” and “a predefined frameset selection object that enables a user to select a predefined frameset arrangement through the graphical user interface.” Neither of these features are not taught or suggested by Kraus or Burns, alone or in combination with one another.

The Examiner relies on Kraus to allegedly teach or suggest a predefined frameset arrangement presentation object claimed by Appellants. See, Office Action, page 2. Specifically, Kraus, at column 2, lines 56-64, is relied upon to teach this claimed feature. The cited portion of Kraus states:

The invention is aimed at the creation of multiple-frame web pages, as opposed to multiple document panes. The capabilities of a web page authoring program, unlike a program for generating paned documents, are limited and determined by the standard formats, such as HTML, used to embody web resources. For example, a multi-frame web page embodied in HTML code will consist of one or more framesets, each of which itself may consist of one or more framesets, including nested and embedded framesets.

The portion of Kraus immediately following this cited portion states:

Furthermore, the relative layout of frames in a web page are constrained by rules governing how the frames must be specified. For example, the sizes of the frames in an HTML page may be specified on one axis only, using an absolute pixel value, a percentage value, or a relative value.

(Kraus, column 2, line 65, to column 3, line 2)

Thus, it appears that Kraus teaches or suggests a multi-frame web page including one or more conventional frames, the arrangement of which must be specified by the user. Nothing about these frames are “predefined frameset

arrangements” as recited in claim 1. For at least this reason, Kraus does not teach or suggest the claimed features of “a predefined frameset arrangement presentation object that presents a plurality of predefined frameset arrangements to a user through a graphical user interface, wherein the plurality of predefined frameset arrangements are displayed as objects to a user” or “a predefined frameset selection object that enables a user to select a predefined frameset arrangement through the graphical user interface.”

The Examiner states that Burns teaches the feature of framesets that are displayed as objects to user. See, Office Action, page 3. Apparently, the Examiner relies on references in Burns to buttons for Restaurants, Ski Rentals, Day Care, etc., to teach this feature. See Burns, Figure 2A, column 5, lines 56-67. According to Burns, these buttons are objects for navigating a user interface, in this case to find information in a kiosk system. Upon a user selecting one of these buttons, the kiosk system displays information associated with the button. See Burns, column 5, lines 26-28.

Even so, Burns does not teach or suggest the features in claim 1 of “a predefined frameset arrangement presentation object that presents a plurality of predefined frameset arrangements to a user through a graphical user interface, wherein the plurality of predefined frameset arrangements are displayed as objects to a user” or “a predefined frameset selection object that enables a user to select a predefined frameset arrangement through the graphical user interface.” Thus, Burns does not make up for the deficiencies of Kraus discussed above.

If neither Kraus nor Burns teaches or suggests these features of the claimed invention, the combination of these references, by definition, cannot teach or suggest the claimed invention. Accordingly, the asserted rejection under 35 U.S.C. § 103(a) of claim 1 is improper and must be withdrawn.

In addition to failing to teach or suggest each of the claimed features, Appellants respectfully submit that the asserted combination of Kraus and Burns is improper for failing to provide some proper suggestion or motivation to modify

the references or combine reference teachings. The Examiner's stated motivation for combining the references is "[i]t would have been obvious to one of ordinary skill in the art, having the teachings of Kraus and Burns at the time the invention was made to modify the predefined frameset arrangement presentation object taught by Kraus to include the plurality of frameset arrangements displayed as objects to a user...." See Office Action, page 3.

The Examiner has not supplied a suggestion or motivation from the references or anywhere else in the prior art as to why one of ordinary skill would modify the teachings of Kraus or Burns. Appellants respectfully submit that there is no motivation for combining the references, absent the disclosure of Appellants own specification. Appellants respectfully request that the rejection be withdrawn.

Claims 8, 15, and 22 include features similar to those discussed above with regard to claim 1. For at least these reasons, Appellants submit that the rejection of these claims are improper and must be withdrawn.

Dependent Claims 2, 9, 16, and 23

Claims 2, 9, 16, and 23 each depend from and add additional features to one of independent claims 1, 8, 15, and 22, respectively. Because neither Kraus nor Burns, alone or in combination with one another, teach or suggest each of the features recited in independent claims 1, 8, 15, and 22, Appellants respectfully submit that dependent claims 2, 9, 16, and 23 are separately patentable for at least the foregoing reasons.

In addition, claims 2, 9, 16, and 23 include the feature of (or features similar to) "enabling a user to specify the number of frames in the predefined frameset arrangement." At least this feature is not taught or suggested in Kraus and Burns, alone or in combination with one another. Apparently, the Examiner relying on the references in Kraus to "creating web pages having any number of frames containing objects such as GIF, JPEG and PNG images, Java Applets, and other framesets" to teach this feature. See column 8, lines 42-55 and figure

9-11. However, this is not equivalent to specifying a number of frames in a predefined frameset arrangement as Kraus does not teach or suggest predefined frameset arrangements as set forth above. Likewise, Burns does not make up for this deficiency of Kraus. Accordingly, for at least this additional reason, Appellants submit that the rejections of claims 2, 9, 16, and 23 are improper and must be withdrawn.

Dependent Claims 3, 10, 17, and 24

Claims 3, 10, 17, and 24 each depend from and add additional features to one of independent claims 1, 8, 15, and 22, respectively. Because neither Kraus nor Burns, alone or in combination with one another, teach or suggest each of the features recited in independent claims 1, 8, 15, and 22, or any intervening claims, Appellants respectfully submit that dependent claims 3, 10, 17, and 24 are also separately patentable for at least the foregoing reasons.

In addition, claims 3, 10, 17, and 24 include the feature of (or features similar to) “the predefined frameset arrangement presentation object presenting the predefined frameset arrangement having the number of frames specified by the user.” At least this feature is not taught or suggested in Kraus and Burns, alone or in combination with one another. Apparently, the Examiner is relying on the references in Kraus to “creating multi-frame web pages where HTML code defining the number and layout of the multiple frames and instructing the computer to display the contents of the hyperlinked resource in a frame” to teach this feature. See column 1, lines 16-30. However, this is not equivalent to presenting the predefined frameset arrangement having the number of frames specified by the user as Kraus does not teach or suggest predefined frameset arrangements as set forth above. Likewise, Burns does not make up for this deficiency of Kraus. Accordingly, for at least this additional reason, Appellants submit that the rejections of claims 3, 10, 17, and 24 are improper and must be withdrawn.

Dependent Claims 4, 11, 18, and 25

Claims 4, 11, 18, and 25 each depend from and add additional features to one of independent claims 1, 8, 15, and 22, respectively. Because neither Kraus nor Burns, alone or in combination with one another, teach or suggest each of the features recited in independent claims 1, 8, 15, and 22, or any intervening claims, Appellants respectfully submit that dependent claims 4, 11, 18, and 25 are also separately patentable for at least the foregoing reasons.

Claims 4, 11, 18, and 25 include the features of (or features similar to) "the predefined frameset arrangement presentation object presenting icons, each icon representing a predefined frameset arrangement." At least this feature is not taught or suggested in Kraus and Burns, alone or in combination with one another. Apparently, the Examiner is relying on references in Kraus to "a graphical image (icon) representing a web resource from a file list, and selecting one of the frames as the target frame by selecting the appropriate area in the miniature image" to teach this feature. See column 5, lines 62-67 and column 6, lines 1-21. However this is not equivalent to an icon representing a predefined frameset arrangement as Kraus does not teach or suggest predefined frameset arrangements as set forth above. Likewise, Burns does not make up for this deficiency of Kraus. Accordingly, for at least this additional reason, Appellants submit that the rejections of claims 4, 11, 18, and 25 are improper and must be withdrawn.

Dependent Claims 5, 12, 19, and 26

Claims 5, 12, 19, and 26 each depend from and add additional features to one of independent claims 1, 8, 15, and 22, respectively. Because neither Kraus nor Burns, alone or in combination with one another, teach or suggest each of the features recited in independent claims 1, 8, 15, and 22, or any intervening claims, Appellants respectfully submit that dependent claims 5, 12, 19, and 26 are also separately patentable for at least the foregoing reasons.

In addition claims 5, 12, 19, and 26 include the features of (or features similar to) “the predefined frameset selection object comprising the icon presented by the predefined frameset arrangement presentation object so that the user may select the icon to select the predefined frameset arrangement that the icon represents.” At least this feature is not taught or suggested in Kraus and Burns, alone or in combination with one another. The Examiner relies on the same teachings of Kraus as discussed above for claims 4, 11, 18, and 25. However this is not equivalent to the icon presented so that the user may select the icon to select the predefined frameset arrangement that the icon represents as Kraus does not teach or suggest predefined frameset arrangements as set forth above. Likewise, Burns does not make up for this deficiency of Kraus. Accordingly, for at least this additional reason, Appellants submit that the rejections of claims 5, 12, 19, and 26 are improper and must be withdrawn.

Dependent Claims 6, 13, 20, and 27

Claims 6, 13, 20, and 27 each depend from and add additional features to one of independent claims 1, 8, 15, and 22, respectively. Because neither Kraus nor Burns, alone or in combination with one another, teach or suggest each of the features recited in independent claims 1, 8, 15, and 22, or any intervening claims, Appellants respectfully submit that dependent claims 6, 13, 20, and 27 are also separately patentable for at least the foregoing reasons.

In addition, claims 6, 13, 20, and 27 include the features of (or features similar to) “the predefined frameset arrangement comprising specification of the size of each frame.” At least this feature is not taught or suggested in Kraus and Burns, alone or in combination with one another. Apparently, the Examiner is relying on references in Kraus to “sizes of the frames in a an HTML code may be specified on one axis only, using an absolute pixel value, a percentage value, or a relative value” to teach this feature. See column 2, lines 61-67 and column 3, lines 1-9. Appellants respectfully submit that Kraus appears to teach specifying sizes of frames in an HTML code while creating an web page. This is not

equivalent to specifying sizes of frames in a predefined frameset arrangement as Kraus does not teach or suggest predefined frameset arrangements as set forth above. Likewise, Burns does not make up for this deficiency of Kraus. Accordingly, for at least this additional reason, Appellants submit that the rejections of claims 6, 13, 20, and 27 are improper and must be withdrawn.

Dependent Claims 7, 14, 21, and 28

Claims 7, 14, 21, and 28 each depend from and add additional features to one of independent claims 1, 8, 15, and 22. Because neither Kraus nor Burns, alone or in combination with one another, teach or suggest each of the features recited in independent claims 1, 8, 15, and 22, or any intervening claims, Appellants respectfully submit that dependent claims 7, 14, 21, and 28 are also separately patentable for at least the foregoing reasons.

In addition, claims 7, 14, 21, and 28 include the feature of "the predefined frameset arrangement comprising specification of the location of each frame within the view." At least this feature is not taught or suggested in Kraus and Burns, alone or in combination with one another. Apparently, the Examiner is relying on references in Kraus to "the page authoring program creating and maintaining a data structure indicating the dimensions of the frame borders and locations of the text and images within the frames, and the pointing device determining location of the frame." See column 4, lines 31-42 and column 5, lines 1-30. This is not equivalent to specifying the location of frames within the view as Kraus does not teach or suggest predefined frameset arrangements as set forth above. Likewise, Burns does not make up for this deficiency of Kraus. Accordingly, for at least this additional reason, Appellants submit that the rejections of claims 7, 14, 21, and 28 are improper and must be withdrawn.

Conclusion

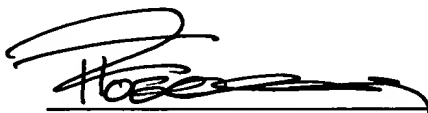
Because the references relied upon by the Examiner, either alone or in combination with one another, fail to disclose, teach or suggest all of the features of the claims as set forth above, Appellants respectfully request that the rejection of each of pending claims 1-28 under 35 U.S.C. §103(a) be reversed.

Respectfully submitted,

MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C.

Dated: February 26, 2003

By:


Rick A. Toering
Registration No. 43,195
For: James G. Gatto
(Registration No. 32,694)

12010 Sunset Hills Road, Suite 900
Reston, VA 20190
Telephone (703) 464-4800
Facsimile (703) 464-4895

APPENDIX A – PENDING CLAIMS

1. A system for enabling a user to create a frameset arrangement for a view comprising:
 - a predefined frameset arrangement presentation object that presents a plurality of predefined frameset arrangements to a user through a graphical user interface, wherein the plurality of predefined frameset arrangements are displayed as objects to a user;
 - a predefined frameset selection object that enables a user to select a predefined frameset arrangement through the graphical user interface; and
 - view presentation object that presents a view to the user having the predefined frameset arrangement selected.
2. The system of claim 1, further comprising a frame number specification object that enables a user to specify the number of frames in the predefined frameset arrangement.
3. The system of claim 2, wherein the predefined frameset arrangement presentation object presents the predefined frameset arrangement having the number of frames specified by the user.
4. The system of claim 1, wherein the predefined frameset arrangement presentation object presents icons, each icon representing a predefined frameset arrangement.
5. The system of claim 4, wherein the predefined frameset selection object comprises the icon presented by the predefined frameset arrangement presentation object so that the user may select the icon to select the predefined frameset arrangement that the icon represents.

6. The system of claim 1, wherein the predefined frameset arrangement comprises specification of the size of each frame.
7. The system of claim 1, wherein the predefined frameset arrangement comprises specification of the location of each frame within the view.
8. A system for enabling a user to create a frameset arrangement for a view comprising:
 - means for presenting a plurality of predefined frameset arrangements to a user through a graphical user interface, wherein the plurality of predefined frameset arrangements are displayed as objects to a user;
 - means for enabling a user to select a predefined frameset arrangement through a graphical user interface; and
 - means for presenting a view to the user having the selected predefined frameset arrangement.
9. The system of claim 8, further comprising means for enabling a user to specify the number of frames in the predefined frameset arrangement.
10. The system of claim 9, wherein the means for presenting a plurality of predefined frameset arrangements presents predefined frameset arrangements having the number of frames specified by the user.
11. The system of claim 8, wherein the means for presenting a plurality of predefined framesets presents icons, each icon representing a predefined frameset arrangement.
12. The system of claim 11, wherein the means for enabling a user to select a predefined frameset arrangement comprises the icon presented by the means for presenting a plurality of predefined frameset arrangements so that the user may

select the icon to select the predefined frameset arrangement that the icon represents.

13. The system of claim 8, wherein the predefined frameset arrangement comprises specification of the size of each frame.

14. The system of claim 8, wherein the predefined frameset arrangement comprises specification of the location of each frame within the view.

15. A method for enabling a user to create a frameset arrangement for a view comprising the steps of:

presenting a plurality of predefined frameset arrangements to a user through a graphical user interface, wherein the plurality of predefined frameset arrangements are displayed as objects to a user;

enabling a user to select a predefined frameset arrangement through the graphical user interface; and

presenting a view to the user having the predefined frameset arrangement selected.

16. The method of claim 15, further comprising the step of enabling a user to specify the number of frames in the predefined frameset arrangement.

17. The method of claim 16, further comprising the step of presenting predefined frameset arrangements having the number of frames specified by the user.

18. The method of claim 15, further comprising the step of presenting icons, wherein each icon represents a predefined frameset arrangement.

19. The method of claim 18, further comprising the step of enabling the user to select the icon to select the predefined frameset arrangement that the icon represents.

20. The method of claim 15, wherein the predefined frameset arrangement specifies the size of each frame.

21. The method of claim 15, wherein the predefined frameset arrangement specifies the location of each frame within the view.

22. A processor readable medium having processor readable code embodied therein for causing a processor to enable a user to create a frameset arrangement for a view, the medium comprising:

processor readable code for causing a processor to present a plurality of predefined frameset arrangements to a user through a graphical user interface, wherein the plurality of predefined frameset arrangements are displayed as objects to a user;

processor readable code for causing a processor to enable a user to select a predefined frameset arrangement through the graphical user interface; and

processor readable code for causing a processor to present a view to the user having the selected predefined frameset arrangement.

23. The medium of claim 22, further comprising processor readable code for causing a processor to enable a user to the number of frames in the predefined frameset arrangement.

24. The medium of claim 23, wherein the processor readable code for causing a processor to present a plurality of predefined frameset arrangements causes a

processor to present predefined frameset arrangements having the number of frames specified by the user.

25. The medium of claim 22, wherein the processor readable code for causing a processor to present a plurality of predefined frameset arrangements causes a processor to present icons, each icon representing a predefined frameset arrangement.

26. The medium of claim 25, wherein the processor readable code for causing a processor to enable a user to select a predefined frameset arrangement comprises code that enables the user to select the icon and thereby select the predefined frameset arrangement that the icon represents.

27. The medium of claim 22, further comprising processor readable code for causing a processor to specify the size of each frame.

28. The medium of claim 22, further comprising processor readable code for causing a processor to specify the location of each frame within the view.

RES 87458v1